| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/528,963 | 03/21/00 | RODRIGUEZ G | 31162 |

HM22/0615

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| EXAMINER |
|---|
| GOLDBERG, J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1614 | 5 |

**DATE MAILED:**
06/15/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner of Patents and Trademarks

| | | |
|---|---|---|
| **Office Action Summary** | Application No. 09/528,963 | Applicant(s) Rodriguez |
| | Examiner Jerome D. Goldberg | Art Unit 1614 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____*1*____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Jun 23, 2000* _____ .

2a) ☐ This action is **FINAL**.　　　2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1*_____ is/are pending in the application.

　　4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1*_____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

　　a) ☐ All b) ☐ Some* c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *4*

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

U. S. Patent and Trademark Office

PTO-326 (Rev. 9-00)　　　　　　　Office Action Summary　　　　　　　Part of Paper No. 5

Claim 1 is directed to a method of formulating a regimen for preventing epithelial ovarian cancer employing an agent based on its ability to upregulate TGF-B expression in the ovarian epithelial. Applicant on page 13, lines 17-21 state that "these products could include progestins, estrogens, androgens, androgen antagonists, progestin antagonists, estrogen antagonists, or other agents including those selected from the group consisting of retinoids, dietary flavanoids, anti-inflammatory drugs, monoterpenes, S-adenosyl-L- methionine, selenium and vitamin D compounds". Applicant is, therefore, required to elect a single compound (agent) for examination on the merits and to add a claim to said compound.

The several inventions above are independent and distinct, each from the other, as they have acquired a separate status in the art as a separate subject matter for inventive effect and require independent searches. It is noted that a reference to one compound (agent) would not be a reference to another compound (agent) under 35 U.S.C. 103. Further, the claims read on a multitude of agents which would require many field of searches that would be an undue burden on the Examiner. Therefore, restriction for examination purposes is proper.

Applicants is required to make a provisional election even though this requirement is traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner J. D. Goldberg whose telephone number is (703) 308-4606. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 3:00 p.m.
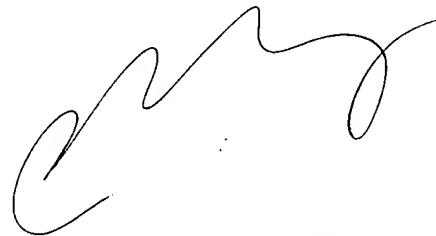
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Marianne Cintins, can be reached on (703) 308-4725. The fax phone number for the

organization where this application or proceeding is assigned is (703) 308-4556 or 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-1235.


J. Goldberg:jmr

May 31, 2001


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